

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: REN ET AL.	§ Confirmation No.: 5019
	§
	§ Group Art Unit: 2162
	§
Serial No.: 09/834,701	§ Examiner: TRUONG, CAM Y T
	§
Filed: April 12, 2001	§ Attorney Docket: REN,01B
	§
For: ADVANCED METHOD AND	§ Date: September 22, 2007
SYSTEM OF AUTOMATIC	§
POPULATION AND	§
MAINTENANCE OF A WEB-	§
BASED DATABASE	

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Commissioner for Patents  
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Alexandria, VA 22313-1450

Sir or Madam:

Applicant's Appeal Brief was rejected as non-compliant by the August 23, 2007 notification. In response thereto, Applicant files this Amended Appeal Brief within the one month time period. Please charge deposit account 501285/DBD/REN-01 for any fee for filing the Amended Appeal Brief and any other fees that may be associated with this communication. The Notice of Appeal was filed on or about December 5, 2006.

**TABLE OF CONTENTS**

Please find enclosed the following sections:

1. REAL PARTY IN INTEREST, beginning on page 3.
2. RELATED APPEALS AND INTERFERENCES, beginning on page 4.
3. STATUS OF CLAIMS, beginning on page 5.
4. STATUS OF AMENDMENTS, beginning on page 7.
5. SUMMARY OF CLAIMED SUBJECT MATTER, beginning on page 8.
6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL,  
beginning on page 13.
7. ARGUMENT, beginning on page 18.
8. CLAIMS APPENDIX, beginning on page 38.
9. EVIDENCE APPENDIX, beginning on page 42.
10. RELATED PROCEEDINGS APPENDIX, beginning on page 43.

**1. REAL PARTY IN INTEREST**

This application has been assigned to AECSOFT USA, INC., a Texas corporation with an address at 5433 Westheimer Road, Suite 730, Houston, Texas 77056. The assignment was recorded on April 12, 2001 at Reel 011704, Frame 0182.

## **2. RELATED APPEALS AND INTERFERENCES**

Applicant is unaware of any other appeals or interferences which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

### **3. STATUS OF CLAIMS**

Claims 1-12, 17 and 19-23 are pending in the application. These Claims were rejected under the following 35 USC 103(a) rejections:

- Claims 1-4, 6, 7, 9, 11, 12, 17 and 21 were rejected as being unpatentable over *Dean et al.* (USPN 6,182,131) in view of *Weinreich et al.* (USPN 6,175,831);
- Claims 24, 25, 27 and 28 were rejected as being unpatentable over *Dean et al.* in view of *Weinreich* and *Ramasubramani et al.* (USPN 6,233,577);
- Claim 5 was rejected as being unpatentable over *Dean* in view of *Weinreich* and further in view of *Champagne et al.* (USPN 6,925,477);
- Claims 8, 10, 20, 22, and 23 were rejected as being unpatentable over *Dean* in view of *Weinreich* and further in view of *Ram et al.* (USPN 6,625,258);
- Claim 26 was rejected as being unpatentable over *Dean* in view of *Weinreich* and *Ramasubramani* and further in view of *Ram*;
- Claims 19 was rejected as being unpatentable over *Dean* in view of *Weinreich* and further in view of *Ram*;

Applicant appeals the rejection of claims 1-12, 17, and 19-28 under 35 U.S.C. 103(a) as being unpatentable over *Dean* '131 in view of *Weinreich* '831 as stated in the Final Office Action of September 5, 2006.

#### **4. STATUS OF AMENDMENTS**

No amendments have been filed in this application since the final rejection of September 13, 2004. All previously filed amendments have been entered.

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

By way of background, the present invention provides an advanced method and system of automatic population, communication and maintenance of a web-based database 32 out of an existing database 10. [¶¶0002, 0006]. The system consists of receiving records of individuals from an existing database 10 into a web-based database 32 without requiring the individuals to register (e.g., without express registration action). The system then creates a temporary access account 40 for each individual record and transmits the access account 40 to the non-registered individuals 60. [Fig. 4]. This allows the individuals to access the web-based database 32 to verify and update their records. [Fig. 7, ¶¶0030-0038]. The system has an auto-updater 130 to automatically download the updated records in the web-based database 32 to the end-user (corporate) computer. [¶0043]. This novel process allows organizations to maintain their customer databases more efficiently and ensures the information in the database is generally more current than it would be without this novel method of managing the database. This novel method is a major improvement over the prior art method of waiting for correspondence to be returned and updating the record based on the returned correspondence.

Claims 1, 17 and 24 were previously amended or added to clarify that Applicants' invention transfers multiple records of individual customers from an



existing corporate database to a second web-based database and does not generally seek to process individual customer data records in an existing database domain, thereby preventing unauthorized modification or corruption of the existing database. The transfer of the maintenance of the customer database information also frees the owner of the existing database from the responsibility of address modification and update. If the customer does not wish to have their records maintained, they may simply ignore the request providing them with their specific unique access account code and their information will not be updated.

Claim 17, representative of Group 2, was also amended to clarify that the invention functions with multiple customer data records and further generates unique access accounts for each of the multiple customer data records. In addition, claim 17 was amended to clarify that Applicants' system enables modification of the customer data records.

Claim 24, representative of Group 3, was previously presented to further claim the invention, and is directed towards a method for customers to update their contact information without registering with the corporate system. Since the customer is accessing his record on the web-based database and not on the internal existing database, no chance for data corruption of the existing database exists. Claim 24 has been further amended to claim the feature of automatic updating based upon additional information provided upon access by the customer. Claim

25 is directed toward specific types of customer information. Claim 26 is directed towards modification of the customer record via a telephone number. Claim 27 is directed towards the modification being a correction.

Please note the section below refers to the *as-filed*, and not published, version of the specification for page and line number citations to the subject matter in independent claims 1, 17, and 24.

Independent claim 1 is directed to a method of automatically populating, maintaining and updating a web-based database. Independent claim 1 is further directed to the steps of a method of automatically populating, maintaining and updating a web-based database. Step (a) of independent claim 1 comprises transferring records of multiple individuals from an existing database to the web-based database automatically and without express registration action in the web-based database. Specifically, one embodiment of an act corresponding to the transferring step (a) of independent claim 1 can be found in Figs. 2-3 (with the existing database denoted by reference character 10 and the web-based database denoted by reference character 32) and at page 5/lines 2-26 of the Detailed Description. Step (b) of independent claim 1 comprises populating a web-based database with the multiple records of the individuals from the existing database without express registration action in the web-based database. One embodiment of an act corresponding to the populating step (b) of independent claim 1 can be

found in Fig. 3 (with the existing database denoted by reference character 10 and the web-based database denoted by reference character 32) and at 5/27-6/25. Step (c) of independent claim 1 comprises creating access accounts for the multiple individuals without express registration action in the web-based database by the individuals. One embodiment of an act corresponding to the creating step (c) of independent claim 1 can be found in Fig. 4 (with access accounts denoted by reference character 40) and at 6/26-7/16. Step (d) of independent claim 1 comprises transmitting at least one access account to at least one of the multiple individuals. One embodiment of an act corresponding to the transmitting step (d) of independent claim 1 can be found in Fig. 5 (with access accounts denoted by reference character 40), Fig. 6 (with access accounts denoted by reference character 40) and at 9/6-20. Step (e) of independent claim 1 comprises enabling remote maintenance of the individual records by the individuals by use of the access account. One embodiment of an act corresponding to the enabling remote maintenance step (e) of independent claim 1 can be found in Fig. 7 and at 10/3-11/9.

Dependent claim 5 is directed to the method of claim 1, wherein the populating of the web-based database with the individual records further comprises automatically mapping the records. One embodiment of an act corresponding to the mapping step of dependent claim 5 can be found in Fig. 3 and at 5/27-6/25.

Dependent claim 8 is directed to the method of claim 1, wherein the access accounts are transmitted to the individual by fax. One embodiment of an act corresponding to the facsimile transmittal step of dependent claim 8 can be found at 7/17-8/2 and 9/6-9/20.

Dependent claim 10 is directed to the method of claim 1, wherein the access accounts are transmitted to the individuals by a media selected from voice mail, physical address, or pager. One embodiment of an act corresponding to the transmittal step of dependent claim 8 via voice mail (denoted by reference character 64), physical address, or pager can be found in Fig. 7-8 and at 7/17-9/26.

Independent claim 17 is directed to a remotely accessible data storage system. Independent claim 17 is further directed to the components of a remotely accessible data storage system. Component (a) of independent claim 17 comprises a web-based database automatically populated with multiple customer data records without express registration action in the web-based database wherein said multiple customer records are transferred from an existing database. Specifically, one embodiment corresponding to the web-based database (a) of independent claim 17 can be found in Figs. 2-4 and 6-9 (with the web-based database denoted by reference character 32) and at 4/16-23 and the transfer at 5/22-26. Component (b) of independent claim 17 comprises an account generator which functions to create multiple access accounts for the multiple customer data records. One

embodiment corresponding to the account generator (b) of independent claim 17 can be found in Figs. 1 and 4 (with the account generator denoted by reference character 110) and at 6/27-7/16. Component (c) of independent claim 17 comprises a broadcast system provided for distributing the multiple access accounts to the multiple customers without a customer request. One embodiment corresponding to the broadcast system (c) of independent claim 17 can be found in Figs. 1 and 6 (with the broadcast system denoted by reference character 120) and at 9/6-20. Component (d) of independent claim 17 comprises an update system provided to enable customer access to the customer data records by use of the access accounts. One embodiment corresponding to the update system (d) of independent claim 17 can be found in Figs. 1 and 7-8 (with the update system denoted by reference character 130) and at 10/3-24.

Dependent claim 19 is directed to the remotely accessible data storage system of claim 17, wherein the customer data records include marketing profiles. One embodiment corresponding to the system of dependent claim 19 can be found at 10/25-11/9.

Dependent claim 20 is directed to the remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access accounts by facsimile. One embodiment corresponding to the system of dependent claim 20 can be found at 7/17-8/2 and 9/6-9/20.

Dependent claim 22 is directed to the remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access accounts by a media selected from voice mail, instant messaging, mail, or by pager. One embodiment corresponding to the system of dependent claim 22 can be found in Fig. 7-8 and at 7/17-9/26.

Dependent claim 23 is directed to the remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access accounts via a combination of fax, email, and voice mail. One embodiment corresponding to the system of dependent claim 23 can be found at 7/17-23 and 9/6-17.

Independent claim 24 is directed to a method of automatically populating, maintaining and updating a web-based database. Independent claim 24 is further directed to the steps of a method of automatically populating, maintaining and updating a web-based database. Step (a) of independent claim 24 comprises transferring multiple customer records comprising contact information of multiple customers from an existing database to the web-based database automatically and without express registration action in the web-based database by the customers. Specifically, one embodiment of an act corresponding to the transferring step (a) of independent claim 24 can be found in Figs. 2-3 (with the existing database denoted by reference character 10 and the web-based database denoted by reference character 32) and at 5/2-26 of the Detailed Description. Reference to “contact

information” can be found at 7/17-26. Step (b) of independent claim 24 comprises populating the web-based database with the records of the multiple customers from the existing database without express registration action in the web-based database. One embodiment of an act corresponding to the populating step (b) of independent claim 24 can be found in Fig. 3 (with the existing database denoted by reference character 10 and the web-based database denoted by reference character 32) and at 5/27–6/25. Step (c) of independent claim 24 comprises creating temporary access accounts for each of the multiple customers without express registration action in the web-based database by the customers. One embodiment of an act corresponding to the creating step (c) of independent claim 24 can be found in Fig. 4 (with temporary access accounts denoted by reference character 40) and at 6/26–7/16. Step (d) of independent claim 24 comprises broadcasting the temporary access accounts to the multiple customers. One embodiment of an act corresponding to the broadcasting step (d) of independent claim 24 can be found in Fig. 6 (with a broadcast system denoted by reference character 120) and at 9/14-17. Step (e) of independent claim 24 comprises enabling remote modification of the customer records by the customers by use of the access account. One embodiment of an act corresponding to the enabling remote modification step (e) of independent claim 24 can be found in Fig. 7 and at 10/3-11/9.

Dependent claim 26 is directed to the method of claim 24, wherein the remote modification is enabled by use of a telephone number. One embodiment of an act corresponding to the enabling remote modification by use of a telephone number of dependent claim 26 can be found at 10/9-24.



**6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether the Examiner discharged her burden of factually supporting her *prima facie* conclusion of obviousness by citing U.S. Patent 6,182,131 to Dean et al. in view of U.S. Patent No. 6,182,131 to Weinreich et al. for claims 1-4, 6, 7, 9, 11, 12, 17 and 21; adding U.S. Patent No. 6,233,577 to Ramasubramani et al. for claim 24-25, 27-28; adding to Dean and Weinreich, U.S. Patent No. 6,925,477 to Champagne for claim 5; adding to Dean and Weinreich, U.S. Patent No. 6,625,258 to Ram et al. for claims 8, 10, 20, 22, and 23; adding to Dean, Weinreich, Ramasubramani, and Ram as to claim 26; and finally adding to Dean and Weinreich, U.S. Patent No. 6,108,691 to Lee for claim 19.<sup>1</sup>
2. Whether the Examiner properly found expressed in each prior art reference some suggestion or motivation to modify the reference or to combine Dean and Weinreich, the combination which forms the basis for each rejection.
3. Whether the Examiner sufficiently identified the reasonable expectation of success of the combination of Dean and Weinreich.

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<sup>1</sup> It should be noted that the Examiner also cited Robertson in a number of rejections (see pages 5, 26, 27 and 29 of the Sept. 5, 2006 Final Office Action), but claimed the reference to Robertson to be a type (sic) error and was not relied upon to support any refusal in the Nov. 21, 2006 Advisory Action. Applicant therefore has not addressed the reference to Robertson in this Appeal Brief.

4. Whether the Examiner adequately established that the prior art references Dean and Weinreich, when combined with Ramasubramani, Ram, Champagne and Lee respectively, teach or suggest all the claim limitations for each set of claim(s) found to be obvious.
5. Whether the Examiner engaged in impermissible hindsight in combining Dean and Weinreich alone or with further combinations of Ramasubramani, Ram, Champagne and Lee, to support her conclusion of obviousness as to all affected claims.

The claims can be grouped as follows:

Group 1: Claims 1-12, directed toward a method of automatically populating, maintaining, and updating a web-based database without requiring prior registration. Claim 1 is representative of the appealed claims of Group 1.

Group 2: Claims 17-23, directed toward a remotely accessible data storage system containing the necessary components to perform the method described in the claims of Group 1. Claim 17 is representative of the appealed claims of Group 2.

Group 3: Claims 24-28 directed toward a web-based contact system capable of broadcasting to, and receiving updating information from customers, in a database securely separated from the originator's existing database system. Claim 24 is representative of the appealed claims of Group 3.

## **7. ARGUMENT**

### **Introduction**

To reject claims for obviousness, the prior art must (1) create a *prima facie* case of obviousness (2) which is un rebutted by Applicant. *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ 2d 1453, 1455 (Fed. Cir. 1998). To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (cited in MPEP 2143); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Merck & Co.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). *See also* MPEP 2142-2143.03. The burden on the Examiner is described as requiring "...rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999). For

the reasons set forth herein, Applicants respectfully will show none of the claimed prior art references relied upon, either alone or in combination, suggest or provide motivation for combining the references in the manner suggested by the Examiner. None of the claimed prior art provides a reasonable expectation of success in achieving the alleged suggested combination, nor do the claimed prior art references teach or suggest all the claim limitations as described in the amended claims provided above. Picking and choosing features from a number of prior art references does not teach or suggest that such features can or should be combined. *Ex Part Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. and Inter. 1985).

**The Examiner wholly failed to show the teaching or motivation to combine Dean '131 with Weinreich '831 from the references in her rejection of all claims**

*Dean*, the primary reference relied upon by the examiner in making the rejection based on obviousness, discloses a system and method for automatically creating user accounts in a second network or domain from an existing account registry of names and possibly passwords, thereby allowing uniformity between database accesses. *Dean* describes automatically creating a user account on a new network or domain for an individual who has an existing and accessible account on a network server. [Col. 2, l. 54-58]. *Dean's* invention will not work for non-registered individuals because *Dean* only functions with individuals that are pre-registered in the account to access the server. *Dean* specifically discloses that the

“user information is maintained in the directory services database” and “the system allows a user to roam to different workstations and access the same user accounts and workstation properties” [col. 4, lines 31-35]. Thus, the starting point for *Dean* varies significantly from the present application. The end-user’s database 10 does not require prior registration by the individual to whom the new registration in the web-based database 32 is offered, only that the name and address and other pertinent information originate in end-user’s database base 32 (for whatever reason). Specifically, *Dean*’s initiating directory is entirely different that applicant’s database 10.

The Examiner misapprehends the standards imposed by the statute and regulations upon the examiner to first review the language of the claim as a whole. MPEP 2141.02. For example, at page 3, the Examiner states: “Clearly, the applied references, *Dean* and *Weinreich* are all concerned to creating user profiles (sic). Thus, these references are analogous and within the same aspects of endeavor and are combinable.” The impermissible leap from “analogous” to “combinable” is one of faith rather than logic, and should be reversed. The Examiner then argues without any explanation of the suggestion or teaching of either reference (Final Office Action, p. 3), that it would have been “obvious to a person of an ordinary skill in the art at the time the invention was made to apply *Weinreich*’s teaching of sending a password to a user and using password to logon the system for updating user profile

in database 70 to *Dean's* system in order to notify users to access their new accounts and further allow users directly update their accounts in a web database any time via Internet quickly without take many hours to change their accounts.”

*Dean* is not—in the least—concerned with creating user profiles, but rather in the wholesale transfer of existing user names (and passwords) to a new database domain to allow sign-on by the existing users of the originating database on the new database domain using the same logon and password. In other words, *Dean* was seeking to increase the scope of domains for which an existing signon (and password) might work as new domains are added to an existing network. Nothing in *Dean* suggests the motivation to create a duplicate Internet database and provide notification and a new password for the potential users of that new database to sign and update their existing individual contact information. *Dean's* transferred sign-on information is isomorphic in the second database with the information contained in the first originating database. Unlike *Dean*, the user is never allowed access to the original database 10 in Applicant's invention. There is no creation of a unique customer number (account access code) performed in the *Dean* reference.

Reliance on the “web-based” database of *Weinreich* is also inapposite. Only one database is being accessed in *Weinreich* and links created to database 70 (accessible through the internet) are in no way similar to creating a new database and allowing vendors to access their specific information in this new web-based database

using a password “blasted” to them upon the creation of the second database in accordance with the teachings of the present application. See Fig. 2 of the present application for a description of Applicants’ topology of the network connections and compare that to Fig. 1 of *Weinreich* reflecting only a single database file system. The web-based database of Applicants’ invention is not synonymous with a web-accessible database of *Weinreich*.

The reliance upon *Dean’s* automatic creation of accounts in the second database from information received from the originating database again suggests the Examiner failed to appreciate the appropriate legal standard for an obviousness rejection. Having reduced Applicants’ invention to the gist of “creating user profiles”, the Examiner completely ignores the problems sought to be solved and the unique and successful manner of solving these problems offered by Applicants’ invention.

Applicant respectfully submits that the prior art references relied on by the examiner failed to establish a *prima facie* case of obviousness with respect to the claims of Groups 1, 2 or 3 and therefore requests that Examiner’s rejection of all claims be set aside.

*Weinreich* describes a social networking system designed for the purpose of creating relationship links between **members** (ie. registered individuals) over a network and providing information to each member based on levels of permission

maintained by the other members to which they are linked. [Col. 14, l. 12-Col. 15, l. 55]. Furthermore, *Weinreich's* invention is based on a single relationship database 70. [Fig. 1]. The database 70 contains contact information entered by *registered users*. [Cols. 7-8]. It is clear that *Weinreich's* personal contact system requires users to *register* to become *members* of the system and only then can their address book (database) be populated with the information of other *registered individuals*.

In addition, the receipt of the records of the *registered individuals* into each personal address book (database) is not automatic, unlike the present invention. Rather a first individual must request that the records of a *registered individual* be added to the first individual's personal address book (database). [Cols. 11-12]. The *registered individual's* information will only be added to the first individual's registered address book if the *registered individual grants the appropriate permission*. [Col. 12, l. 37-47].

The conclusion reached by the examiner that it would have been obvious to a person of an ordinary skill in the art at the time of the invention was made "to apply Weinreich's teaching of sending a password to a user and using password to logon the system for updating user profile in database 70 to Dean's system in order to notify users to access their new accounts and further allow users directly update their accounts in a web database anytime via Internet quickly without taking many



hours to change their accounts....” does not satisfy the “clear and particular” showing of motivation to combine the references required. *In re Dembiczak*, 175 F. 3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Even if, assuming *arguendo*, *Dean* in view of *Weinreich* is capable of rendering Applicant’s invention obvious when combined, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Even if *Dean* and *Weinreich* taught the limitation “without registration” (which they don’t), both *Dean* and *Weinreich* teach away from their combination with *each other* to supply the “without registration” limitation because both clearly requires registration. [].

Furthermore, it is improper to modify references where the modifications proposed renders the prior art references unsatisfactory for their intended purpose, and there is no suggestion or motivation to make the proposed modifications. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The examiners proposed modifications requiring *Dean* and *Weinreich* to function “automatically and without registration” and “without action taken by the customer” renders each reference unsatisfactory for its intended purpose, and thus there is no suggestion or motivation

to make the proposed modifications. Each reference requires the user to be previously "registered".

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. [FN15] This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

*In re Fritch*, 972 F.2d 1260, 1266, 23 PQ2d 1780, 1784 (Fed. Cir. 1992).

Additionally, because the modifications to each reference proposed by the examiner would change the principle of operation of the prior art inventions being modified, the teachings of the references are likewise insufficient to render the claims *prima facie* obvious on this ground. *In re Ratti*, 270 F.2d 819, 123 USPQ 349 (CCPA 1959). The examiner's proposed combinations are incapable of rendering the claims of Group 1 or Group 2 or Group 3 obvious because there is no suggestion or motivation to combine *Dean* and *Weinreich*.

Contrary to the conclusions drawn by the Examiner, the mere fact that a reference can be modified is not sufficient to establish a *prima facie* case of obviousness. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. To support the conclusion that the claimed invention is directed toward obvious subject matter, the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious

in light of the teachings of the reference. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 2142.

Examiner has presented no such line of reasoning and none exists. All the references relied upon by examiner (*Dean*, *Weinreich*, *Ramasubramani*, *Champagne*, *Ram* and *Lee*) are clearly contrary to Applicant's invention that requires the data to transfer automatically and "without registration". Considering the purpose of each of the cited prior art references as a whole, it would not have been obvious to one of ordinary skill in the art to modify the prior art to function automatically and "without registration" as claimed by Applicant in Groups 1, 2 and 3.

None of the prior art relied upon by the Examiner addresses the problem solved by Applicants. None of the prior art cited suggests or offers any motivation to combine the references cited by the Examiner and the Examiner does not rely upon knowledge generally available, to modify the reference or to combine reference teachings. *Dean*, the primary reference relied upon, is a patent for automatically populating a second network or domain by polling an existing network or domain for a plurality of existing user names, which are then passed to a second network account manager program which creates an account in the second network for each of the plurality of user names exactly as they are shown in the originating database.

This automatic population saves the original plurality of users from the need to individually sign into the second network to set up their own user name on the second network. [Col. 1, lines 36-43]. The automatic population feature is intended to save each user from having to sign onto a new database and establish an account using their sign-on and password. The system did not intend to create or teach creating a unique new account access code and password and forwarding that password to parties outside of the organization so that they could sign-on to the web-based database to correct information relied upon by the creating entity to contact them of the present claimed invention. Rather, *Dean's* signon (and password, if passed) will be the same in both the originating database and the new database. If *Dean* created a unique signon, known only to the outside customer, the whole purpose of *Dean's* automatic creation of identical accounts in a second database domain would have been frustrated.

*Weinreich* describes creating, updating and maintaining a single networked database wherein each user of the database may create relationship fields to allow linking to other users having similar relationship fields in their respective records. This permits searching or organizing the database by relationships rather than individual account identifiers. [See generally Cols. 3 and 4.] Each user must become a "member." (ie. register), by their separate registrations in the database. See the description of the BAM routine of the DSP 12. [Col. 7, lines 4-23.] Each

“user” is pre-registered in the system before the linking takes place. Unlike the present application, *Weinreich* does not broadcast a password signon to individuals outside of those who initialized their own account within the system.

The Examiner engaged in inappropriate “picking and choosing” of separate features from each of these patents to argue that the Applicants’ invention would have been obvious to one having ordinary skill in the art, without the slightest hint of analyzing how the separate prior art patents suggested or taught the combination.

The fact that references can be combined or modified is insufficient to establish a *prima facie* obviousness rejection. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is insufficient by itself to establish *prima facie* obviousness. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). The proposed modification of *Dean*, the primary reference, to create unique account numbers would render *Dean* unsatisfactory for its intended purpose because the originating user would not be able to sign into the newly opened database domain. The proposed modification of *Weinreich* to allow user signons and modifications of the “web-based” database 70 is contrary to the Applicants’ plan to establish a second web-based database 32, Fig. 2, which prevents unauthorized or

inappropriate modification of the vendor records on the existing database 10.

*Weinreich* is inapplicable to the present invention.

Applicants respectfully request that Examiner's rejection of all claims based upon *Dean* and *Weinreich* be overturned.

**The Examiners Citation of *Dean* in view of *Weinreich* to reject claims 1-4, 6, 7, 9, 11-12, 17, 21 is Error**

Claim 1 is rejected under 35 USC §103 because of *Dean* in view of *Weinreich*. The Examiner argues that *Dean* teaches automatic creation of user accounts in an external network so that users may access that external network, ie. users within the owner's network are automatically signed into the remote network. This is not the same as customer records being used to create a database in a web-based database to allow the customer to update the individual customer records within that database for later selective access by the owner of the originating existing database. The *Dean* disclosure does not foresee the customer accessing its record and correcting the information contained in the database. Most importantly, *Dean* assumes the timeliness and integrity of the information transmitted to the newly opened network database domain. Applicants assume the information is stale, unreliable and in need of correction. Applicants' invention intends for the individual customer to access and correct any outdated, incorrect or misinformation contained within the web-based database. As the Examiner

cogently admits “[t]he account manager of the ISP is not maintained and updated.

The account manager of the ISP is a storage and not a web-based database.” Office Action, p. 4. Applicants’ and *Dean*’s system are significantly different and teach away from each other.

The account registry, which is copied in *Dean*, is part and parcel of the operating system and creates a gateway into the initiating database for a browsing party. To allow a stranger, to have access to this information would completely compromise the original database system as well as the operating system upon which it resides. Clearly, *Dean* cannot be readily combined with any of the other cited prior art references to support an obviousness rejection, and no system manager would allow such a wholesale access to his operating system records.

Claim 17, the second independent claim the Examiner deems obvious because of *Dean* in view of *Weinreich* is likewise rejected because the Examiner picked and chose elements from prior art which was claimed to be the same as that disclosed and claimed. The Auto-Populator feature of the claimed invention clearly takes database information and establishes a new web-based database with fields populated from the owner’s database. [Figs. 1-2, ¶¶0019, 0022-24] This new web-based database then assigns new account identification to the customer accounts transferred and automatically broadcasts a message to the customer with a sign-on and password wholly different than those of the originating database to

allow the customer to sign on and update its records on the system. [Fig. 6, ¶¶0033-34.] This is entirely different than the topology of the *Dean* disclosure where the original users are being automatically signed into a newly opened database system so that the multiple users in the first database would not be required to sign onto the system and create a new account one by one. No outsider will ever be allowed to access the newly created database of *Dean* since it is only to be accessed by the existing identified users. As previously noted, *Dean*'s account registry 30 from the LAN 10 is part of the operating system of the originating database and is generally only accessible to operating system personnel having sufficient privileges to allow access to this sensitive information. [See *Dean*, Col. 2, line 65-Col. 3, line 7.] As such, it contains the vital information necessary to give priority and privileges to requests made by the user. This information is not generally made available beyond the confines of the original operating system registry. This information is never made available to other users. *Dean* is not analogous to the creation and use of a second database for contacting customers.

Applicants' web-based database claimed in claim 17 is wholly unlike *Dean*'s newly-opened database domain and cannot be combined with the single database system of *Weinreich* to make claim 17 obvious. The ability to sign onto the *Weinreich* database (for those who have previously become members and



obtained their own passwords through the BAM routine previously discussed, and who have previously sought to create relationship fields within their own record to link with other users, is certainly not analogous to allowing a single user accessing their account to correct customer information errors while at the same time permitting rapid communication to all database-listed customers. The Examiner jumped from using a password to sign into the system to the conclusion that *Weinreich* taught the creation and sending of a password to a user new to the system. Accordingly, the Examiner again wholly failed to establish a prima facie obviousness rejection by use of the *Dean* and *Weinreich* prior art references.

Similarly, Applicants' third independent claim 24 describes a method of automatically populating, maintaining and updating a web-based database created from customer records obtained from an existing database. Applicants' comments relating to claims 1 and 17 are incorporated herein by reference. As previously noted, although the Examiner concedes the account manager of the ISP is "a storage and not is a web-based database...." [Final Office Action at page 13], Applicants specifically claim a web-based database. No indication exists that *Dean* creates new unique temporary access accounts for each of the multiple customers, nor checks those temporary access accounts for duplications and validity, nor broadcasts those temporary access accounts to the customer, previously unregistered, with instructions to use the temporary account to sign into

the web-based database to update their own records, thus relieving the originating operating system from the burden and security issues of having third parties access an internal database (the “originating database” of the disclosure).

Applicant respectfully request that Examiner’s rejection of claims 1-4, 6, 7, 9, 11-12, 17, 21 be set aside.

**The Examiner’s Citation of *Dean* in view of *Weinreich* and *Ramansubramani* to reject claims 24-25 and 27-28 is Error**

In the Final Office Action of September 5, 2006, the Examiner found a new reference to *Ramansubramani* to combine with *Dean* as primary reference and *Weinreich* to reject claims 24, 25, 27 and 28. As previously noted, by picking and choosing elements of each cited prior art reference (and irrespective whether the references suggest they could be reasonably combined) the Examiner rejects claims 24 based on *Dean* and *Weinreich* and adds *Ramansubramani* to discuss a user changing his username and password (but for not other apparent purpose). Claim 25 was rejected based upon *Dean*’s contact information being combined with e-mail contact information found in *Weinreich* to suggest it would have been obvious to combine the two. Although there is no indication of the compatibility of the two systems described with each other. *Ramansubramani* relates to the ability of a thin-client to access the authorized certificate database, using a previously established digital key, and modify the user name and password identified with that

digital key. The significant data containing the digital certificate and the encryption key has already been passed to the thin-client. The teaching of *Ramansubramani* cannot be combined with *Dean* and *Weinreich* to make any feature of Applicants' invention obvious. *Ramansubramani* provides a database of user certificates for timely and efficient association with, and an updating of, a user device thereby allowing secure communication between the user device (such as cell phone) through the secure network. This system permits the use of digital certificates and distribution of those certificates from a database to thin clients (having little or no memory or computing power). This feature allows management of an existing secure connection without unnecessary restriction on the user device. There is absolutely no similarity between the claimed invention of the present application and the invention disclosed in *Ramansubramani*. The Examiner uses the self-provisioning description to argue that *Ramansubramani* discloses accessing the central database to download the name and password to the thin-client (ie. cell phone). Clearly, some greater explanation of the pertinence of *Ramansubramani* should be required before this reference is used to suggest obviousness.

For example, as noted above, the Examiner cites *Ramansubramani* solely for the proposition that it allows a user to change his username and password. Office Action, p. 25. The Examiner concludes this section "It would have been

obvious...to apply Weinreich's teaching of sending a password to a user and using password to logon the system for updating user profile in database 70 and Rama teaches a user may change his username and password to Dean's system in order to notify users to access their new accounts and further allow users directly update their accounts in a web database anytime via a network system quickly without take many hours to change their accounts and prevent other users access a personal account of a user without permission." Significantly, and fatally to the position taken by the Examiner, there is no suggestion in any of the references relied upon for this summary argument for combining the references in the manner not claimed to be "obvious."

The Examiner retreats as to claim 28 to using *Dean* and *Weinreich* as prior art references to find the claim obvious. Thus apparently only claim 24 is rejected over the combined references of *Dean*, *Weinreich*, and *Ramansubramani*. The Examiner has wholly failed to show how these prior art references suggest or teach the combination claimed to have been made obvious, and Applicants respectfully request the Examiner more fully explain the teachings of each to support the motivation to combine these disparate references. Applicant respectfully requests Examiner's rejection of claims 24-25, 27-28 be set aside.

**The Examiner's Citation of *Dean* in view of *Weinreich* and further in view of *Champagne* to reject claim 5 is Error**

Although claim 5 is dependent from claim 1, the Examiner further cites *Champagne* as making claim 5 obvious because automatic mapping was done prior to Applicants' filing. As acknowledged in Applicants' disclosure, "mapping of database fields is well known in the art, and one of ordinary skill in the art will recognize the numerous ways of accomplishing such mapping." Para. 24. The Examiner's reliance upon *Champagne* in combination with *Dean* and *Weinreich* is again picking and choosing features and refusing to recognize the claimed invention "as a whole." It is not automatic mapping that's patentable, but rather the entirety of Applicants' claimed invention that's unobvious and therefore patentable. No explanation of the prior art is offered in the context of the invention claimed as a whole and therefore the Examiner has wholly failed to discharge the burden of establishing a prima facie obviousness rejection. *Champagne* is a patent for a system which automatically populates a second database from records in first database irrespective of the correspondence between the fields of each database using a field mapping process which directs a data transfer protocol to establish the link between the first and the second databases. Applicant respectfully requests that Examiner's rejection of claim 5 be set aside.

**The Examiner's Citation of *Dean* in view of *Weinreich* and further in view of *Ram* to reject claims 8, 10, 20, 22, 23 and 26 is Error**

*Ram* is combined with *Dean* in view of *Weinreich* to support the Examiner's rejection of claims 8, 10, 20, 22, 23 and 26. While it is not entirely clear how each of the cited references are combined because the Examiner wholly fails to specify the teaching in each which leads to the conclusion they are combinable, it appears that the function of telephone, pager, or fax communication is the intended manner of communication sought to be made obvious. The combination of these forms of communication with the disclosures of *Dean* and *Weinreich* is really not explained by the Examiner. Again, the communication feature is selectively picked from the cited prior art reference and offered as proof of the obviousness of the claimed combination claimed in Applicants' disclosure. No explanation of how the references teach or suggest the combination is offered and thus the Examiner has failed to carry her burden of establishing a *prima facie* obviousness claim in the present case. Consequently, the Examiner has failed to establish even a *prima facie* case of obviousness with the cited prior art references. *Ram* is a patent for a communication management system which coordinates telephone and data services through a virtual [communications] assistant system, VAS, which allows subscriber access to phone messages from e-mail access portals, listening or sending e-mails from a telephone, forwarding of e-mails to a fax machine, through a single number access for each subscriber/user. [Col. 3, lines 33-51.] While there is a database [324A in Fig. 3] and there is communication through the Internet,

there is very little similarity or teaching of the application of telephone communication with Applicants' invention. The voicemail and pager system described at col. 3, lines 45-50 and at col. 14, lines 55-63, relied upon by the Examiner does not teach the blast fax broadcasting of specific notices to database users to update their respective information, nor provide the implementation to accomplish this updating. Moreover, the VAS described in *Ram* does permit modification of the account characteristics through a web portal to a specific web page to modify rate plans and the like, but it does not permit the user to modify a web-based database maintained by the voicemail provider with personal information, as contemplated by Applicants. Applicants respectfully request that Examiner's rejection of claim 8, 10, 20, 22, 23 and 26 be set aside.

**The Examiner's Citation of *Dean* in view of *Weinreich* and further in view of *Lee* to reject claim 19 is Error**

The Examiner picks and chooses *Lee* in combination with *Dean* and *Weinreich* to attempt an obviousness rejection of claim 19. *Lee* teaches providing a method of receiving e-mail messages without disclosing the e-mail address of the recipient so the user will not be bothered with excessive junk e-mail blasts. The Examiner uses *Lee* to support an obviousness rejection by supposing Applicants' invention related to the sending of multiple database records to different vendors. While, again, it is not entirely clear how this cited prior art relates to the rejected

claim 19, Applicants assert the Examiner was again engaging in impermissible picking and choosing of features to establish obviousness without consideration of the claimed invention as a whole. Applicants respectfully request that the Examiner's rejection of claim 19 be set aside.

**Dependent Claims Should be Allowed if the Independent Claim is Allowed**

Irrespective of the arguments made above, Claims 2-4, 6, 7, 9, 11, and 12 all depend from claim 1 and would be allowable if claim 1 is allowable. Claims 19-24 all depend from claim 17 and would be allowable if claim 17 is allowable. Claims 25-28 all depend from claim 24 and would be allowable if claim 24 is allowable. See MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**Conclusion**

It is respectfully submitted that there is no *prima facie* case of obviousness from the cited references and that the claims are directed to a meritorious advance of the art, deserving of patentability. It is respectfully submitted that the rejection of claims 1-12 (Group 1) , 17-23 (Group 2) and 24-28 (Group 3) was improper and should be reversed.

Respectfully submitted,

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## **8. CLAIMS APPENDIX**

A clean copy of the claims involved in the appeal is as follows:

1. (rejected) A method of automatically populating, maintaining and updating a web-based database, the method comprising the steps of:
  - (a) transferring multiple records of individuals from an existing database to the web-based database automatically and without express registration action in the web-based database;
  - (b) populating a web-based database with the multiple records of the individuals from the existing database without express registration action in the web-based database;
  - (c) creating access accounts for the multiple individuals without express registration action in the web-based database by the individuals;
  - (d) transmitting at least one access account to at least one of the multiple individuals; and
  - (e) enabling remote maintenance of the individual records by the individuals by use of the access account.
2. (rejected) The method of claim 1, wherein the records are received by transfer across an electronic link.
3. (rejected) The method of claim 2, wherein the electronic link is electronic mail.
4. (rejected) The method of claim 2, wherein the electronic link is selected from satellite systems, cable systems, direct modem connections, network connections, VPN connections, or Intranet connections.

5. (rejected) The method of claim 1, wherein the populating of the web-based database with the individual records further comprises automatically mapping the records.
6. (rejected) The method of claim 1, wherein the populating of the web-based database with the individual records further comprises manually mapping the records.
7. (rejected) The method of claim 1, wherein the access accounts are generated automatically.
8. (rejected) The method of claim 1, wherein the access accounts are transmitted to the individuals by fax.
9. (rejected) The method of claim 1, wherein the access accounts are transmitted to the individuals by email.
10. (rejected) The method of claim 1, wherein the access accounts are transmitted to the individuals by a media selected from voice mail, physical address, or pager.
11. (rejected) The method of claim 1, wherein the remote maintenance occurs across the Internet.
12. (rejected) The method of claim 1, wherein the remote maintenance comprises altering the individual records.

Claims 13–16. (cancelled)

17. (rejected) A remotely accessible data storage system, comprising:

- (a) a web-based database automatically populated with multiple customer data records without express registration action in the web-based-database wherein said multiple customer records are transferred from an existing database;
  - (b) an account generator provided for creating multiple access accounts for the multiple customer data records;
  - (c) a broadcast system provided for distributing the multiple access accounts to the multiple customers without a customer request; and
  - (d) an update system provided to enable customer access to the customer data records by use of the access accounts.
18. (cancelled)
19. (rejected) The remotely accessible data storage system of claim 17, wherein the customer data records include marketing profiles.
20. (rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access accounts by facsimile.
21. (rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access accounts by email.
22. (rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access accounts by a media selected from voice mail, instant messaging, mail, or by pager.
23. (rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access accounts by a combination of fax, email, and voice mail.
24. (rejected) A method of automatically populating, maintaining and updating

a web-based database, the method comprising the steps of:

- (a) transferring multiple customer records comprising contact information of multiple customers from an existing database to the web-based database automatically and without express registration action in the web-based database by the customers;
- (b) populating the web-based database with the records of the multiple customers from the existing database without express registration action in the web-based database;
- (c) creating temporary access accounts for each of the multiple customers without express registration action in the web-based database by the customers;
- (d) broadcasting the temporary access accounts to the multiple customers; and
- (e) enabling remote modification of the customer records by the customers by use of the access account.

- 25. (rejected) The method of claim 24 wherein the contact information comprises at least one type of information chosen from the group consisting of: mailing address; phone number; voice mail number; cellular phone number; pager number; beeper number; fax number; and email address
- 26. (rejected) The method of claim 24 wherein the remote modification is enabled by use of a telephone number.
- 27. (rejected) The method of claim 24 wherein the modification is a correction.
- 28. (rejected) The method of claim 24 wherein the broadcasting is performed by at least one means chosen from the group consisting of: facsimile; email; telephone; mobile telephone; pager; and standard mail.

## **9. EVIDENCE APPENDIX**

Please find attached a copy of each reference cited:

1. Dean et al., U.S. Patent No. 6,182,131.
2. Weinreich et al., U.S. Patent No. 6,175,831.
3. Ramasubramani et al., U.S. Patent No. 6,233,577.
4. Champagne et al., U.S. Patent No. 6,925,477,
5. Ram et al., U.S. Patent No. 6,625,258,
6. Lee et al., U.S. Patent No. 6,108,691.

**10. RELATED PROCEEDINGS APPENDIX**

None.